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## TRANSMITTAL FORM

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Total Number of Pages in This Submission

46

Application Number

10/523,866

Filing Date

September 15, 2005

First Named Inventor

Anahit Tataryan

Art Unit

1772

Examiner Name

Nasser Ahmad

Attorney Docket Number

110-015.US (formerly AVER-70396)

### ENCLOSURES (Check all that apply)

☐

Fee Transmittal Form

☐

Fee Attached

☐

Amendment/Reply

☐

After Final

☐

Affidavits/declaration(s)

☐

Extension of Time Request

☐

Express Abandonment Request

☐

Information Disclosure Statement

☐

Certified Copy of Priority Document(s)

☐

Reply to Missing Parts/  
Incomplete Application

☐

Reply to Missing Parts  
under 37 CFR 1.52 or 1.53

☐

Drawing(s)

☐

Licensing-related Papers

☐

Petition

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Petition to Convert to a  
Provisional Application

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Power of Attorney, Revocation

☐

Change of Correspondence Address

☐

Terminal Disclaimer

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Request for Refund

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CD, Number of CD(s) \_\_\_\_\_

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Remarks

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After Allowance Communication to TC

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Appeal Communication to Board  
of Appeals and Interferences

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Appeal Communication to TC  
(Appeal Notice, Brief, Reply Brief)

☐

Proprietary Information

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Status Letter

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Other Enclosure(s) (please identify  
below):

1. Postcard

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Intellectual Property Law Office of Joel D. Voelzke

Signature

Printed name

Joel D. Voelzke

Date

May 4, 2007

Reg. No.

37,957

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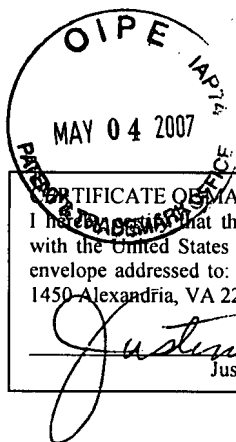
Justina S. Townsend

Date

May 4, 2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/523,866 Confirmation No.: 1881  
Applicant : Anahit Tataryan  
Filed : September 15, 2005  
Art Unit : 1772  
Examiner : Ahmad, Nasser  
Title : Send-Reply Label

Docket No.: : 110.015.US (formerly AVERY-70396) May 4, 2007  
Customer No. : 47533

SUPPLEMENTAL RESPONSE TO  
NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

This paper is in further response to the Notification of Non-Compliant Appeal Brief dated April 24, 2007, and is in response to the telephone call from Examiner Ahmad to the undersigned in which he advised the undersigned that merely filing a Replacement Sheet 2 would be insufficient and that an entire copy of the corrected Appeal Brief should be filed.


Accordingly, Applicant encloses a complete copy of the corrected Appeal Brief including the Appendices.

Respectfully submitted,

INTELLECTUAL PROPERTY LAW OFFICE OF  
JOEL D. VOELZKE

DATED: May 4, 2007

By:

  
\_\_\_\_\_  
Joel D. Voelzke  
Registration No. 37,957

Serial No. 10/523,866  
Supplemental Response to  
Non Compliant Appeal Brief

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2007

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*Justina Townsend*  
Justina Townsend



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Anahit Tataryan et al.

Examiner: Nasser Ahmad

Serial No. 10/523,866

Group Art Unit 1772

Filed: February 7, 2005

Docket No. 110-015.US  
(formerly Avery-70396)

For: SEND-REPLY LABEL

APPEAL BRIEF

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

A Notice of Appeal from the Office Action of September 18, 2006 was filed on  
December 7, 2006. Applicants now file this Appeal Brief in support of Applicants' Appeal.

Enclosed herewith is a check in the amount of \$500 for filing this Appeal Brief, in  
accordance with 37 C.F.R. §41.20(b)(2).

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The PTO did not receive the following  
listed item(s) CEL - S.U.U - U.D

**I. REAL PARTY IN INTEREST**

The real party in interest is AVERY DENNISON CORPORATION ("Avery"). This application was originally assigned to Avery by an assignment of the original priority application, which the Patent Office recorded on April 1, 2005, beginning at reel 016416, Frame 0904.

**II. RELATED APPEALS AND INTERFERENCES**

None.

**III. STATUS OF CLAIMS**

The following is a statement of the status of all the claims, pending or cancelled. Only some of the rejected claims are hereby appealed.

Claims 1, 2, 5-8, 10-14, 17-19, and 28-31 are rejected.

Claims 3, 4, 9, 15, 16, 20-27 are cancelled.

The claims on appeal are: Claims 1, 13, 28, 30, and 31.

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#### **IV. STATUS OF AMENDMENTS**

The Applicants filed a first amendment dated June 23, 2006. That amendment was accorded a filing date of June 27, 2006. In response to that Amendment, the Examiner issued a Final Office Action. No further amendments were filed. Consequently, the claims that are currently pending are those submitted with the amendment filed June 27, 2006.

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**V. SUMMARY OF THE CLAIMED SUBJECT MATTER**

The following is a concise explanation of the invention defined in the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawings by reference characters, as appropriate. It is to be understood that any reference to a specific embodiment of the invention in the specification and/or drawings is not intended to limit the scope of the claims. For purposes of being concise, not all of the claims are summarized, and a full understanding of the invention must be gained by study of the specification and claims.

The application is directed to a particular label construction which the Applicants have termed a send-reply label. A label sheet has special cuts such that after being printed upon such as by a desktop printer, the send-reply label may be removed and adhered to a first envelope or package to provide the "from" address, and then, after the addressee has received the envelope or package and wishes to mail a response, the addressee can easily peel off an inner label that contains the "From" address and adhere that label to a return envelope or package as the new "To" address. In other words, a single label construction provides both the original "From" mailing address for a first mailing, and a subsequent "To" mailing label for the reply.

Alternatively, the present invention could provide both the "To" address for the mailing of a first envelope, and the "From" address for a second envelope. Alternatively still, the present invention could provide both the original "To" address and the reply "From" address (or vice versa) for a subsequent mailing or shipment of the same envelope or package when it is forwarded or sent back by the original addressee. Whether used in any or all of those ways, the present invention makes it easier for the original addressee to send his or her reply in the mail.

An example of the label being used is shown in **Fig. 4** which is reproduced below.

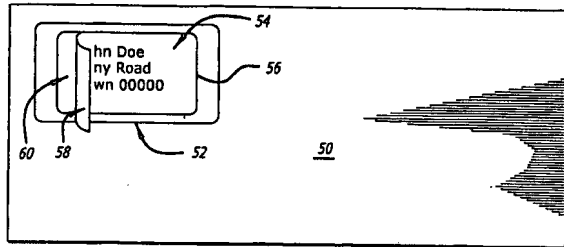


FIG. 4A

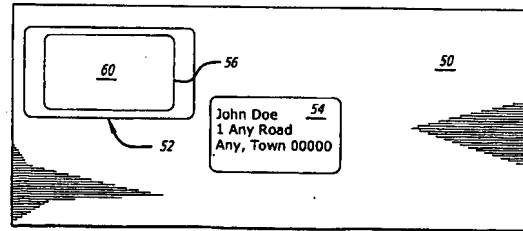
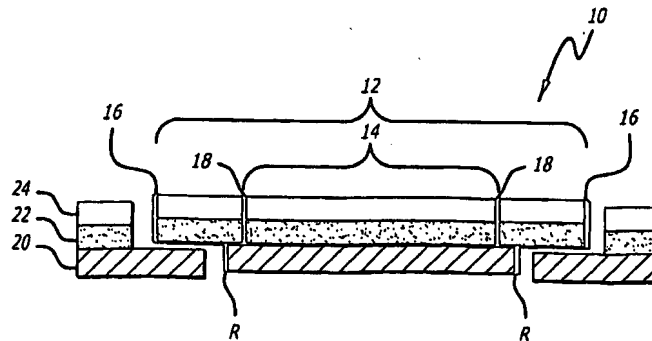


FIG. 4B

Fig. 4A shows the present invention being used to provide the “From” address in a first mailing of an envelope. Fig. 4B shows the inner label being used to provide the “To” address in a reply mailing of that same envelope.

A cross section of the label construction is shown below:



Before discussing the claims, it may be useful to discuss terminology within the label construction arts. A typical label sheet, such as a 8-1/2" x 11" sheet containing multiple mailing labels and which can be printed on using a desktop printer, includes a “face stock” layer adhered to a “liner sheet” layer, with multiple die cuts in the facestock layer to define a number of removable labels. One popular size label sheet contains 30 labels pre-cut into an 8-1/2" x 11" sheet, and is typically used to print mailing labels. The term “face stock” refers to the material which is to be printed upon. That face stock layer is usually opaque paper, but can be other types of material such as clear mylar. The “liner sheet” refers to the sheet of material on the backside of the label sheet. The liner sheet typically includes a thin layer of release material such as silicone on it. After printing the label sheet in a printer, a label is peeled away from the release



liner sheet, leaving a sticky-backed label that can then be adhered to an object such as an envelope. The terms “face stock,” and “liner” or “release liner member,” are used in the claims consistent with the foregoing terminology.

#### Claim 1

Independent claim 1 generally relates to a particular label construction with mailing information printed on it. The construction includes a face stock layer (24, 12; specification at p. 7, lines 19 and 21) that is backed with an adhesive (22; p. 7, line 19). The face stock layer (24, 12) has a pattern of cuts (16, 18; p. 7, lines 16 and 24) in it that defines a removable sub-label (14; p. 7, line 26). The removable sub-label (14) has mailing information (see Fig. 4A, 4B) printed on it (p. 12, lines 23-24). A release liner member (between the lines R-R, hereafter simply “R-R”) backs and extends beyond the removable sub-label (14) and backs less than the entire area of the face stock layer (24, 12) (p. 10, lines 23-25). This construction, together with the mailing information printed on it, allows the face stock layer (12) with the mailing information on it and part of the release liner member (R-R) to be adhered via the adhesive to a first object to be mailed to provide mailing information for the first object. The removable sub-label (14) may subsequently be removed from the release liner member (R-R) by peeling it away, and adhered to a second object to be mailed to provide mailing information for that second object.

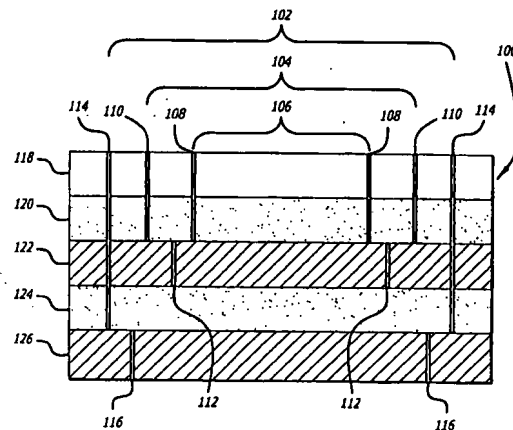
#### Claim 13

Independent claim 13 relates to a label construction that includes a face stock layer (24) that is back with adhesive (22). A first cut pattern (16) in the face stock layer and the adhesive defines an outer label (12). A second cut pattern (18) in the face stock layer and the adhesive defines an inner label (14) within the outer label (12). Mailing information (see Fig. 4A, 4B) is printed on the inner label (p. 12, lines 23-24). A release liner member (20) is applied to the

adhesive. A third cut pattern (**R**) in the release liner member (**20**) defines an area (**R-R**) of the release liner member (**20**) that backs and extends beyond the inner label (**14**), and that backs less than an entire area of the face stock layer and the adhesive (**12**).

### Claim 28

Independent claim 28 relates to a send-reply label that has a printed facestock layer, and *two* liner sheets with respective adhesive layers. The construction is shown in Figure 6, and is described on pp. 11-12 of the specification. The addition of the second liner sheet, with associated cuts, allows the send-reply label of claim 28 to be used a total of three times, rather than the two times provided by the invention as previously described.



In the construction as claimed in claim 28, the multi-layer label assembly (**100**) includes a face stock layer (**118**) coated with adhesive (**120**) and backed with a first release liner (**122**). A second release liner (**126**) backs the first release liner (**122**), with the two liner layers (**122**, **126**) being separated by a layer of adhesive (**124**).

A first line of weakness pattern (**114**) extends through the face stock layer (**118**) and through the first release liner layer (**122**), to -- but not through -- the second release liner layer (**126**). That first line of weakness pattern (**114**) defines a first removable label (**102**).

A second line of weakness pattern (110) within the first line of weakness pattern (114) extends through the face stock layer (118) to -- but not through -- the first release liner layer (122). That second line of weakness pattern (110) defines a second removable label (104).

A third line of weakness pattern (116) in the second release liner (126) extends through the second release liner (116) but not the face stock layer (118). That third line (116) is disposed intermediate to the first and second lines of weakness patterns (114, 110).

A fourth line of weakness pattern (108) extends through the face stock layer (118), and defines a third removable label portion (106).

A fifth line of weakness pattern (112) in the first release liner (122) is disposed intermediate to the second and fourth lines of weakness patterns (110, 108).

Mailing information is printed on the third removable label portion (106).

#### Claim 30

Independent claim 30 is a method claim that recites a structure for a send label that includes an inner label, an outer label, and a release liner adhered to both labels; and further recites the steps of printing mailing information on the inner label and then removing the send label and placing it on a first object to be mailed.

#### Claim 31

Dependent claim 31 depends from independent method claim 30, and adds the steps of mailing the first object, then removing the inner label from the send label, and adhering the inner label to a second object to be mailed to provide mailing information thereon.

While this Summary summarizes in a non-limiting manner major aspects of the independent claims, other aspects are found in the specification and claims, which are attached in the Appendix of Claims Involved in the Appeal.

**VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The grounds of rejection to be reviewed on appeal are as follows:

**A. Rejection of Claims 1 and 30-31 Under 35 USC 102(b) for Anticipation by Aoyagi (4,032,679)**

Claims 1 and 30-31 are rejected under 35 U.S.C. § 102(b) for anticipation by Aoyagi (4,032,679). The Examiner contends that:

Aoyagi relates to a multi-removable label construction (figure-2) comprising a face stock layer (21) that is backed with adhesive (22), a cut pattern (24) in the face stock layer that defines a removable sub-label (21a) within said face stock layer, a release liner member (23) that backs and extends beyond said removable sub-label, and that backs less than the entire area of the face stock layer (extends up to 25).

The sub-label is imprinted and the adhesive is pressure sensitive adhesive (abstract).

Aoyagi also teaches the method for re-using a portion of the label.

As for the presence of mailing information print, it is understood that the presence of printed information (as the sub-label is imprinted) will include mailing information as it is considered to be printed information.

The intended use phrase such as "may be" and the functional phrases "whereby" have not been given any patentable weight because said phrases are not found to be of positive limitations.

The Examiner further states, in his response to Applicant's argument submitted in the most recent Amendment, that:

Applicant[‘s argument] that both Aoyagi and Stipek fails to teach the printing of mailing information on the labels . . . is not found to be convincing because both Aoyagi and Stipek anticipates the label structure as claimed, including information printed thereon.

As for the information being mailing information, it is understood by the examiner that the information printed would include mailing information as the mailing information is considered to be printed information.

(Final Office Action, at page 3, paragraph 8)

**B. Rejection of Claims 1, 13, and 30-31 Under 35 USC 102(b) for Anticipation by Stipek (3,914,483)**

Claims 1, 13, and 30-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Stipek (3914483). The Examiner contends that:

Stipek relates to a multi-removable label construction (figure-1) comprising a facestock layer (17) that is backed with adhesive (19), a cut pattern (23) in the facestock layer that defines a removable sub-label (13) within said facestock layer, a release liner member (25) that backs and extends beyond said removable sub-label, and that backs less than the entire area of the facestock layer (figure-1).

Figure-1 shows that the label is imprinted.

The facestock layer comprises pressure sensitive adhesive coated paper (col. 1, lines 51-54).

The construction of figure-1 shows that the label comprises a plurality of labels.

Further, the multi-label sheet assembly comprises a first removable label (13), a second removable label (41) that is formed within the first removable label (figures 1 and 2).

Stipek also teaches a method of re-using a portion of the label comprising the steps of providing the label, attaching the first label to a first substrate (figure-3), removing at least one second label and attaching it to a second substrate (figure-4).

Regarding the print being mailing information, it is understood by the examiner that the presence of printed information of the facestock would include mailing information as it is considered to printed information.

The intended use phrase such as "may be", "to be mailed", etc. and the functional phrases "whereby" have not been given any patentable weight because said phrases are not found to be of positive limitations.

(Final Office Action, at page 4, paragraph 9)

**C. Rejection of Claim 28 Under 35 USC 103(a) for Obviousness Over Stipek in  
View of Rawlings (6,170,879)**

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stipek in view of Rawlings (6,170,879). The Examiner contends that:

Stipek, as discussed above, fails to teach the presence of a second release liner backing the first release liner. Rawlings relates to a piggy-back label construction comprising a first release liner backed by a second release liner as shown in figure-3. therefore, it would have been obvious to one having ordinary skill in the art to utilize Rawlings' teaching of using a second release liner backing the first release liner in the invention of Stipek with the motivation to provide for re-usability of the label. Regarding the presence of fourth and fifth lines of weaknesses of claim 28, it would have been obvious duplication of parts, absent any showing of criticality by the applicant.

(Final Office Action at pages 6-7, paragraph 13).

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## **VII. ARGUMENT**

This application is directed to a send-reply label. The send-reply label generally comprises a label that may be printed upon such as by a desktop printer, removed and adhered to a first object to be mailed, and an inner label thereafter removed and placed on a second object to be mailed such that a recipient of the first package or envelope can simply remove the inner label off the package and place it on a reply package or envelope for mailing.

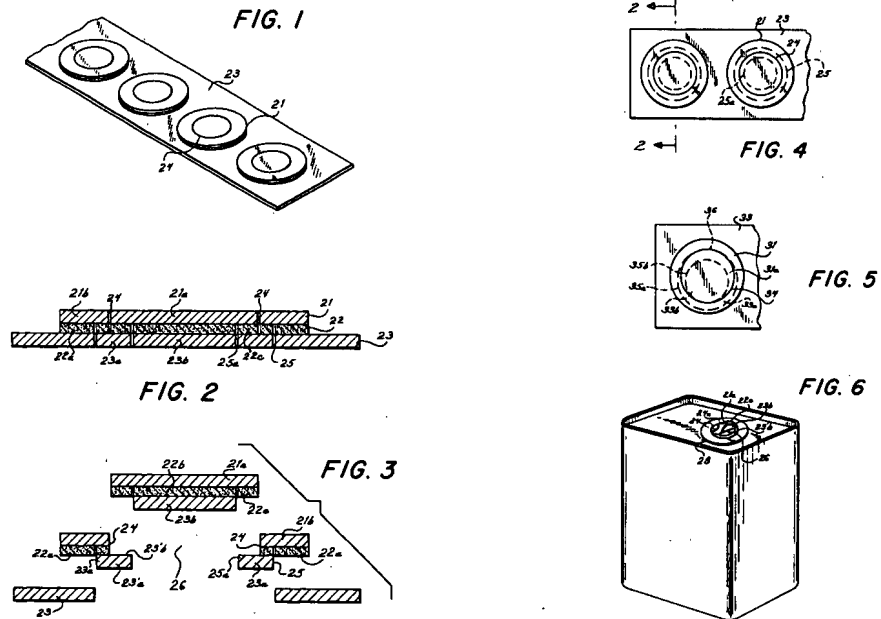
Claims 1, 13, 28, and 30-31 are at issue in this appeal. Those claims are variously rejected as anticipated and/or rendered obvious by Aoyagi (4,032,679), Stipek (3,914,483), and Rawlings (6,170,879), in various combinations.

### **A. The Prior Art**

Before discussing the claims and the rejections in detail, it may be helpful to review the two prior art references principally relied upon by the Examiner.

#### **1. Aoyagi (4,032,679)**

Aoyagi, entitled simply “Sticker,” discloses a set of circular stickers that have a round central portion 21a and an annular outer portion 21b, with the annular portion 21b being detached from the corresponding sticker 21a, and the annular pieces being used for a seal on packages of medicine and the like, and the corresponding pieces 23a attached to an invoice which is sent to the recipient of the medicine packages so that the recipient can correlate the invoice to the received package of medicine (column 2, lines 25-38). Aoyagi further suggests that the round sticker and annular portion can provide a circular opening seal for a can of “granular cleaner” (presumably, scouring powder such AJAX® brand cleanser) so that the can of powder can be repeatedly opened and re-sealed (column 2, line 66 – column 3, line 25). All figures (Figures 1-6) from Aoyagi are reproduced below.



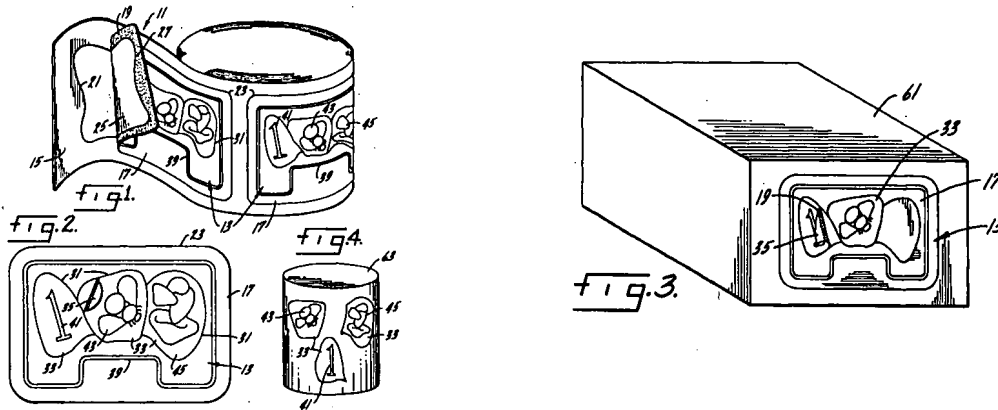
Figures 1-6 of Aoyagi (4,032,679)

Aoyagi does not mention any uses for his round stickers that relate in any way to mailing, or providing reusable mailing labels such as the unique and easy to use send-reply labels as claimed.

2. Stipek (3,914,483)

Stipek discloses a roll of labels which can be used as coupons or decorative stickers (Abstract), with the overall sticker being stuck on one object, and a number of different inner stickers with different artistic decorations thereon being removed and applied to an object to be decorated with the various decorative stickers. Figures 1-3 are reproduced below.





**Figures 1-3 of Stipek (3,941,483)**

Stipek suggests that his structure would be particularly useful as coupons, or for labeling sub-parts of packages. (column 2, lines 49-53) Stipek neither discloses nor suggests that mailing information should be printed on the decorative stickers, or that the stickers could be used as send-reply labels. Stipek does not mention mailing or addressing anywhere in the patent.

**B. The Claims**

**1. Claim 1**

**a. Rejection of Claim 1 as Anticipated by Aoyagi (4,032,679)**

Claim 1 is rejected as anticipated by Aoyagi (4,032,679). The Examiner contends that Aoyagi discloses the physical structure of the claimed invention. In addition to disclosing particular physical structure, however, the claim also recites the positive limitation that the structure:

ha[s] mailing information printed thereon . . .

whereby the face stock layer and release liner member may be adhered via the adhesive to a first object to be mailed providing mailing information for said first object, and said removable sub-label thereafter may be removed from said release liner member and adhered to a second object to be mailed to provide mailing information for said second object.

With respect to those important limitations, the Examiner states rather vaguely that:

As for the presence of mailing information print, it is understood that the presence of printed information (as the sub-label is imprinted) will include mailing information as it is considered to be printed information.

(Final Office Action at page 3, paragraph 8).

Applicants disagree. It is unclear to the undersigned exactly what the Examiner's position is, but the Examiner appears to be arguing that because Aoyagi discloses printing *something* on his round stickers such as medicine packaging information, that it follows that Aoyagi necessarily discloses printing *any and all possible information* on the stickers including mailing information as claimed by Applicant. That reasoning is not sound. That same line of reasoning could be extended to reject every claimed invention on the basis of any reference no matter how irrelevant. For example, the Examiner could argue for any given invention and any arbitrarily chosen reference, "As for the Applicant's claimed structure, it is understood that the cited prior art reference discloses a structure, and the Applicant's claimed structure is understood to be one type of structure. Therefore, the structure claims are anticipated under 35 U.S.C. § 102(b) by the cited reference."

Applicants point out that the Examiner did not reject claim 1 as obvious under 35 U.S.C. § 103(a). If the Examiner had issued an obviousness rejection, Applicants could then address any reasoning on which the §103(a) rejection were based. The Examiner, however, has rejected the claim only as anticipated under §102(b) by Aoyagi. Aoyagi, however, does not disclose or suggest a label with "mailing information printed thereon" . . . whereby the structure provides a convenient send-reply label, as claimed. The claim as currently presented is not anticipated by Aoyagi. The claim rejection should be overturned for at least that reason. The claim is also not rendered obvious by Aoyagi, which has nothing to do with providing mailing information.

b. Rejection of Claim 1 as Anticipated by Stipek (3,914,483)

Claim 1 is further rejected under 35 U.S.C. § 102(b) as being anticipated by Stipek (3,914,483). With respect to the important limitations discussed above with respect to mailing information being printed on the label so as to create a removable and repositionable mailing address label, the Examiner makes the same contention with respect to Stipek as with respect to Aoyagi, namely:

Regarding the print being mailing information, it is understood by the examiner that the presence of printed information of the facestock would include mailing information as it is considered to printed information.

Once again, the Examiner appears to be assuming that disclosure of printing *anything* including the decorative designs on Stipek's decorative labels necessarily discloses printing *everything* on decorative labels. Applicants respectfully but strongly disagree for the same reasons as stated above with respect to Aoyagi's medicine labels / scouring powder closures.

2. Claim 13

Claim 13 recites a structure somewhat similar to the structure recited in claim 1, the structure including an inner label and an outer label created by cut patterns in a facestock layer above a release liner member adhered to the facestock layer via adhesive. Claim 13 recites that the inner label has "mailing information printed thereon."

Claim 13 is rejected under 35 U.S.C. § 102(b) as anticipated by Stipek. The Examiner contends:

Regarding the print being mailing information, it is understood by the examiner that the presence of printed information of the facestock would include mailing information as it is considered to printed information.

(Final Office Action at page 4, paragraph 9).

Once again, the Examiner has interpreted Stipek's disclosure of decorative designs on labels as somehow constituting a disclosure of mailing information on the inner label, while in

fact Stipek never mentions or suggests mailing information on the labels or using one of his decorative labels to provide a reusable mailing label such as a convenient send-reply label.

3. Claim 28

Claim 28 relates to a send-reply label that includes a single facestock sheet and *two* release liners, so that the label can be re-used for a total of three different mailings. The claim recites the structure of the two release liner layers, and the single face stock layer, with adhesive between the layers, and recites particular die cuts through the various layers at various places in order to create the three-times usable send-reply label.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stipek in view of Rawlings (6,170,879). The Examiner contends that:

Stipek, as discussed above, fails to teach the presence of a second release liner backing the first release liner. Rawlings relates to a piggy-back label construction comprising a first release liner backed by a second release liner as shown in figure-3. therefore, it would have been obvious to one having ordinary skill in the art to utilize Rawlings' teaching of using a second release liner backing the first release liner in the invention of Stipek with the motivation to provide for re-usability of the label. Regarding the presence of fourth and fifth lines of weaknesses of claim 28, it would have been obvious duplication of parts, absent any showing of criticality by the applicant.

(Final Office Action at pages 6-7, paragraph 13).

Applicants respectfully disagree. Rawlings relates to a structure which involves rather complex manufacturing steps to produce a *piggyback* label (i.e., a label-on-a-label) which may be placed on a package, and then the top label may be peeled away to reveal a second recipient address label *underneath* the first address label so that the same package can be re-shipped to a new recipient. (Col. 2, lines 28-32; col. 2, lines 46-51) Rawlings's structure involves *pre-printing* the second address 22 atop the liner 20 during the manufacturing process of the laminate 14. (Col. 2, lines 52-55) Because Rawlings requires pre-printing of the second label, Rawlings

does not relate to the send-reply label of the present invention which may be sold in blank form and thereafter printed upon by a personal computer using a desktop printer. Additionally, Rawlings relates to a single label construction to be placed on a package, with a layer peeled away to reveal a second address below the first address. This is the exact opposite of the present invention, which provides a single label which can be removed from a first package and then placed on a second package to provide the *same* address as first a send address and then a reply address, and in the case of claim 28 can be removed yet again and provide the same address on a *third* package. The claimed construction is far more than mere duplication of parts, and would not be rendered obvious by the much different construction of Rawlings, which must be manufactured and pre-printed by a much different process, and which is used in a much different way to produce the exact opposite result.

4. Claims 30 and 31

Claim 30 and 31 are method claims directed to a method of printing and using a send-reply label. Claim 30 recites:

30. A method for printing and using a send-reply label comprising:  
providing a facestock sheet having . . . [a particular recited structure];  
printing mailing information on said inner label; and  
removing said send label and adhering said send label to a first object to  
be mailed to provide said mailing information thereon.

Claim 31 depends from claim 30, and add the steps of:

mailing said first object;  
removing said inner label of said send label from said first object; and  
adhering said inner label to a second object to be mailed to provide said  
mailing information thereon.

The Examiner has rejected claims 30 and 31 as a group with claim 1. The Examiner contends that claims 30 and 31 including the recited method steps are anticipated by Aoyagi and Stipek. The only statement by the Examiner regarding where the recited method steps are found within the cited references is:

As for the presence of mailing information print, it is understood that the presence of printed information (as the sub-label is imprinted) will include mailing information as it is considered to be printed information.

(Final Office Action at page 3, paragraph 8).

Applicants respectfully but strongly disagree that the recited steps are disclosed and hence anticipated by Aoyagi or Stipek. As pointed out above with respect to claim 1, Aoyagi suggests using a round sticker and a corresponding annular outer sticker on two different items (e.g., a medicine package and an invoice corresponding to the medicine) in order for someone to be able to correlate the invoice to the medicine received, or using the round sticker as a resealable closure for a can of "granular cleaner" (apparently, scouring powder such as AJAX® brand cleanser). Aoyagi nowhere discloses, and in no way suggests, the recited method steps of:

printing mailing information on said inner label; and

removing said send label and adhering said send label to a first object to be mailed to provide said mailing information thereon.

as recited in claim 30, or the further method steps of:

mailing said first object;

removing said inner label of said send label from said first object; and

adhering said inner label to a second object to be mailed to provide said mailing information thereon.

as recited in claim 31.

Nor does Stipek with his disclosure of removable decorative labels disclosure or suggest the above important steps, and the Examiner does not state where Stipek contains any such disclosure.

CONCLUSION


For the foregoing reasons, it is submitted that the present invention as claimed is not anticipated or rendered obvious by any of the cited references taken either singly or in combination. Appellant respectfully requests reversal of the rejection of the appealed claims.

Respectfully submitted,

INTELLECTUAL PROPERTY LAW OFFICE OF  
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DATED: 5/3/07

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## **VIII. CLAIMS APPENDIX – THE CLAIMS ON APPEAL**

1. A multi-removable label construction comprising:  
a face stock layer that is backed with adhesive;  
a cut pattern in the face stock layer that defines a removable sub-label within said face stock layer, said removable sub-layer having mailing information printed thereon;  
a release liner member that backs and extends beyond said removable sub-label, and that backs less than the entire area of the face stock layer;  
whereby the face stock layer and release liner member may be adhered via the adhesive to a first object to be mailed to provide mailing information for said first object, and said removable sub-label thereafter may be removed from said release liner member and adhered to a second object to be mailed to provide mailing information for said second object.

13. A multi-removable label construction comprising:  
a face stock layer that is backed with adhesive;  
a first cut pattern in the face stock layer and the adhesive that defines an outer label;  
a second cut pattern in the face stock layer and the adhesive that defines at least one inner label within said outer label, said inner label having mailing information printed thereon;  
a release liner member applied to the adhesive; and  
a third cut pattern in the release liner member that backs and extends beyond said inner label, and that backs less than an entire area of the face stock layer and the adhesive.

28. A multi-layer label assembly comprising:  
a face stock layer coated with adhesive;  
said face stock layer being backed with a first release liner layer;



a second release liner layer backing said first release liner; a layer of adhesive between said first and second release liner layers;

a first line of weakness pattern in said face stock layer defining a first removable label, said first line of weakness extending through the face stock layer and the first release liner layer to the second release liner layer;

a second line of weakness pattern within said first line of weakness pattern defining a second removable label, said second line of weakness extending through said face stock layer to the first release liner layer;

a third line of weakness pattern in said second release liner, said third line of weakness pattern being intermediate to said first and second line of weakness patterns, said third line of weakness pattern extending through the release liner but not the face stock layer;

a fourth line of weakness pattern in said face stock layer, said fourth line of weakness pattern extending through said face stock layer, said fourth line of weakness pattern defining a third removable label portion, said fourth line of weakness being within said second line of weakness pattern;

a fifth line of weakness pattern in said first release liner, said fifth line of weakness pattern being intermediate to said fourth line of weakness pattern and said second line of weakness pattern; and

mailing information printed on said third removable label portion;

whereby the second and third removable label portions may be adhered to a first object to be mailed to provide a send address label thereon, and after the object has been received by a recipient the third removable label portion may be removed and placed elsewhere to provide a reply address label.

30. A method for printing and using a send-reply label comprising:

providing a facestock sheet having:

an outer label formed in said facestock sheet and an inner label formed via a die cut within said outer label; and

a release liner sheet adhesively adhered to said inner and outer labels via a releasable adhesive, said release liner sheet having a die cut therein disposed generally outside of said inner label and inside of said outer label to form a releasable liner member;  
said inner label, said outer label, and said releasable liner member forming a send label;  
printing mailing information on said inner label; and  
removing said send label and adhering said send label to a first object to be mailed to provide said mailing information thereon.

31. The method of claim 30 further comprising:  
mailing said first object;  
removing said inner label of said send label from said first object; and  
adhering said inner label to a second object to be mailed to provide said mailing information thereon.

**IX. EVIDENCE APPENDIX**

The evidence relied upon comprises the references currently relied upon by the Examiner, specifically, the following U.S. Patents:

4,032,679     Aoyagi

3,914,483     Stipek

6,170,879     Rawlings

A copy of each reference relied upon by the Examiner is attached hereto on the following pages.

**X. RELATED PROCEEDINGS APPENDIX**

There are no related proceedings.